

U.S. Patent Application No.: **10/564,361**
Amendment Filed: **October 28, 2008**
Reply to Office Action dated: **July 9, 2008**

REMARKS

Claims 1, 3-6, 13-15, 21-23, 29, and 30 are currently pending in this application, and stand rejected. Claims 1, 13, 15, 21, 23, and 29 are independent claims in the application. Claims 3-6 depend, either directly or indirectly, from Claim 1. Claim 14 depends upon Claim 13. Claim 22 depends upon Claim 21. Claim 30 depends upon Claim 29.

Claims 1, 13, 15, 22 and 23 are amended by this response. Claims 31, 32, and 33 are added in this response. The applicants assert that no new matter has been added by this response. The applicants further assert that these amendments and accompanying remarks are fully responsive to the office action dated **July 9, 2008**.

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. In response the applicants have amended claim 1 to recite “A telephone”, instead of “A telephone for displaying”. As such, withdrawal of the § 112 rejection of claim 1 is now in order and respectfully solicited. Due to their dependence upon claim 1, withdrawal of the § 112 rejection of claims 3-6 is also now in order, and respectfully solicited.

Claims 23, 29, and 30 stand rejected under 35 U.S.C. § 101 for being directed towards non-statutory subject matter. Particularly, the office action asserts that, “these claims recite a ‘computer program’ not associated with a computer readable medium”, such that the claims are not directed towards statutory subject matter.

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However, in July 1998, the Court of Appeals for the Federal Circuit, in the case of *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), suggested that almost any unobvious software-related invention is patentable if the claims are properly drawn. The patent involved in the *State Street Bank* case, U.S. Patent No. 5,193,056, is generally directed to a data processing system for implementing an investment structure dealing with the administration and accounting of mutual stock funds.

The court held that the transformation of data in a software-related patent (*e.g.*, in the *State Street Bank* case, which represented “discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price”) constitutes:

- (a) a “practical application of a mathematical algorithm, formula, or calculation,” but
- (b) nevertheless, produces “a useful, concrete and tangible result.”

In the instant case, the claimed programs, as set forth Claims 23, 29, and 30, provide, among other, “useful, concrete and tangible result[s]” the ability to determine that the telephone number satisfies a predetermined condition, triggering the program to calculate and display the local time (Claim 23).

Further, the applicants disagree that claim 23 does not recite any structure. In particular, it is asserted that the limitation of the program “having a telephone provided with a storage unit” provides sufficient structure under § 101.

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Regarding claims 29 and 30, the program recited therein acts upon a telephone system. In a similar case, *AT&T Corp. v. Excel Communications, Inc.*, 172 F.2d 1352, 50 USPQ2d 1352 (Fed. Cir. 1999), the Federal Circuit suggested that a process or system which is to be implemented using computer code, even on a system which is not owned or operated by the patentee, is potentially patentable subject matter. With this in mind, and relying on the reasoning of *State Street Bank*, the *AT&T* court held that the patent directed toward a system of billing customers for long distance calling based on which long distance carrier they subscribed was patentable subject matter under § 101, even though the patentee did not own or claim the physical network upon which the invention would be practiced. Thus, the court found that a system designed to work upon a communications network satisfied the conditions of § 101, even though the system was implemented by computer code. The court then entered an order reversing the District Court's finding that the Claims were not directed to patentable subject matter under § 101, and remanded the case with instructions to scrutinize the claims under §§ 102, 103 and 112. Because the program of Claims 29 and 30 are acting on a telephone system being similar to the system of *AT&T*, claims 29 and 30 are also patentable.

Please also note that claims 31, 32 and 33 are added herein, being recording media having the program of claims 23, 29, and 30 being recorded thereon, respectively. These claims find support on pages 32-35 of the specification.

The office action rejects claims 1, 5, 6, 13, 14, 15, 21-23, 29, and 30 under 35 U.S.C. § 102(b) as being anticipated by Katagishi et al. (U.S. Patent Pub. No. 2002/0168997). In making this rejection, the office action asserts that Katagishi et al. discloses each and every element

found in these claims. Particularly regarding claims 1, 15, and 23, the office action asserts that these elements are found in paragraphs [0007] and [0009].

However, paragraphs [0007] and [0009] merely disclose that (i) there are cellular phones with international roaming functions, (ii) these international roaming functions have been put into practical use in GSM communications, and (iii) Katagishi et al. aims to allow displaying a local time of a locality of a callee. These paragraphs neither disclose, nor suggest, a method of judging whether a callee's telephone is capable of roaming.

Further, the office action also indicates that the storage unit (or storing step), is shown in the flowchart of figure 15 of Katagishi et al. However, Katagishi et al. does not disclose anything about a telephone of the caller storing therein region information of the callee in association with (i) identification information identifying the callee or (ii) a telephone number. Hence, according to Katagishi et al., in order to display a local time of a locality of the callee when calling the callee, it is necessary to acquire region information of a telephone of the callee from a base station with which the location of the telephone of the callee is registered. Since Katagishi et al. does not disclose the storage unit storing therein the region information of the telephone of the callee, it naturally does not disclose a calculation unit for calculating the local time of the locality of the callee with reference to the region information stored in the storage unit in the telephone of the caller.

Conversely, in the present application, if the region information of the telephone of the callee is stored in the storage unit at the time of calling the callee, then it is possible to identify a

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time zone to which the telephone of the callee belongs and calculate the local time of the locality of the callee with use of (i) the time difference between the time zone to which the telephone of the callee belongs and a time zone to which the telephone of the caller belongs and (ii) the time counted by the telephone of the caller. This beneficially makes it possible to calculate the local time of the locality of the callee based on the prestored region information, without taking the trouble to access the base station with which the location of the telephone of the callee is registered. Such a feature is not anticipated, or obvious in view of Katagishi et al. because it is neither disclosed therein nor would one of ordinary skill in the art be able to ascertain such dramatic benefits would not be expected by placing such processing within in the telephone of the caller.

When calling the callee, a telephone with the above structure saves time and effort in acquiring the region information by accessing the base station with which the location of the telephone of the callee is registered. At the same time, the above structure also helps control electrical power consumption in acquiring the region information during a phone call. These effects cannot be achieved if the telephone of the caller does not store therein the telephone number of the callee in association with the region information of the callee, as stated in the above storing unit (claim 1) or storing step (claims 15 and 23).

As such, claims 1, 15, and 23 are now in condition for allowance and believed to be patentable. Withdrawal of the § 102(b) rejection of claims 1, 15, and 23 is now in order and respectfully solicited.

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Because claims 5 and 6 depend upon claim 1, the office action fails establish anticipation of these claims under § 102, or establish a prima facie case of obviousness, for claims 5 and 6. As such, claims 5 and 6 are in condition for allowance and believed to be patentable. Withdrawal of the rejection of claims 5 and 6 under 35 U.S.C. § 102(b) is now in order and respectfully solicited.

Because claims 1, 15, and 23 are not anticipated under § 102, or obvious under § 103, independent claims 13, 21 (method), and 29 (method), having the same structure as these claims, are also not anticipated or obvious in view of Katagishi et al. As such withdrawal of the outstanding rejections of claims 13, 21, and 29 are also now in order and respectfully solicited.

Regarding the rejections of claim 14, 22, and 30, the office action asserts that Katagishi et al. discloses the call unit of claim 14, as well as the calling step of claims 22 and 30, in paragraph [0052] and Step 704 of Fig. 16. However, these sections merely disclose call processing being performed when a user inputs into the telephone of the caller an instruction to make a telephone call. They do not disclose the structure of the call unit or the calling step (for example, “calling the first telephone if a predetermined time period elapses without receiving an instruction from the second telephone after notifying the region information to the second telephone”).

As such, claims 14, 22, and 30 are now believed to be patentable and in condition for allowance. Withdrawal of the 35 U.S.C. § 102(b) rejection of claim 14, 22, and 30 is now in order and respectfully solicited.

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The office action rejects claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Katagishi et al. Regarding claim 3, the office action acknowledges that Katagishi et al. does not disclose an acquiring unit receiving a modulation signal representing the region information, in an audible frequency band from a telephone of the callee, and acquiring the region information by decoding the received modulation signal. Regarding claim 4, the office action acknowledges that Katagishi et al. does not receiving an electronic mail disclosing region information from a telephone of a callee, and the acquiring unit acquiring the received region information from the electronic mail. The office action asserts that both of these elements are well known within the art, thus making their inclusion in claims 3 and 4 obvious under § 103(a).

However, because, as discussed above, Katagishi et al. does not anticipate or render obvious the elements of independent claim 1, Katagishi et al. also does not render its dependent claims obvious because each and every element of a claim must be rendered anticipated or obvious for a *prima facie* showing obviousness. *See, e.g., CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“[O]bviousness requires a suggestion of all limitations in a claim.”). Because the office action fails to establish such a *prima facie* case for the elements of claim 1, by their dependence upon claim 1, the office action also fails to establish a *prima facie* case of obviousness for dependent claims 3 and 4.

As such, claims 3 and 4 are now in condition for allowance and believed to be patentable. Withdrawal of the 35 U.S.C. § 103(a) rejection of claims 3 and 4 is now in order and respectfully solicited.

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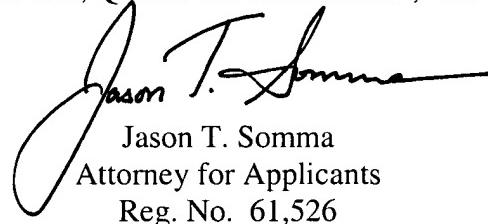
In view of the aforementioned amendments and accompanying remarks, claims 1, 3-6, 13-15, 21-23, and 29-33 are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees that may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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